Office Action Summary

Application No.	Applicant(s)	
10/032,106	PENG ET AL.	
Examiner	**Art Unit**	
Prema M Mertz	1646	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 22-42 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 22-42 are subject to restriction and/or election requirement.

PC - Rest. Resp Due - LD
DOCKETED IBJ
Due:
REMINDER: 5/13/04
FINAL DUE DATE: 10/13/04

IP - Rest. Resp Due - LD
DOCKETED IBJ
Due:
REMINDER: 5/13/04
FINAL DUE DATE: 10/13/04

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 22-26, drawn to a heterodimeric receptor complex, a vector comprising the polynucleotides encoding said receptor complex and a method of making said receptor complex, classified in class 435, subclass 69.1.

II. Claims 27-38, 39, drawn to a method of treating a subject by administering an agonist (nucleic acid of SEQ ID NO:5) of IL-B50, classified in class 514, subclass 44.

III. Claims 27-38, 39, drawn to a method of treating a subject by administering an agonist (protein of SEQ ID NO:6) of IL-B50, classified in class 514, subclass 2.

IV. Claims 27-38, 40, drawn to a method of treating a subject by administering an antagonist (nucleic acid of SEQ ID NO:5) of IL-B50, classified in class 514, subclass 44.

V. Claims 27-38, 40, drawn to a method of treating a subject by administering an antagonist (protein of SEQ ID NO:6) of IL-B50, classified in class 514, subclass 2.

VI. Claims 27, 40, 41, drawn to a method of treating a subject by administering an antagonist (antibody to SEQ ID NO:2), classified in class 424, subclass 130.1.

VII. Claims 27, 40, 41, drawn to a method of treating a subject by administering an antagonist (antibody to SEQ ID NO:4), classified in class 424, subclass 130.1.

VIII. Claims 27, 40, 41, drawn to a method of treating a subject by administering an antagonist (antibody to SEQ ID NO:6), classified in class 424, subclass 130.1.

IX. Claims 27, 40, 41, drawn to a method of treating a subject by administering an antagonist (antisense to SEQ ID NO:1), classified in class 514, subclass 44.

X. Claims 27, 40, 41, drawn to a method of treating a subject by administering an antagonist (antisense to SEQ ID NO:3), classified in class 514, subclass 44.

XI. Claims 27, 40, 41, drawn to a method of treating a subject by administering an antagonist (antisense to SEQ ID NO:5), classified in class 424, subclass 130.1.

XII. Claims 27, 40, drawn to a method of treating a subject by administering an antagonist (soluble receptor from SEQ ID NO:2), classified in class 514, subclass 2.

XIII. Claims 27, 40, drawn to a method of treating a subject by administering an antagonist (soluble receptor from SEQ ID NO:4), classified in class 514, subclass 2.

XIV. Claim 42, drawn to an antibody to a heterodimeric receptor complex, classified in class 530, subclass 387.9.

Applicants are advised that claims 27-42 are improper Markush claim because the multiple elements recited therein are agonists, antagonists, nucleic acids, polypeptides, and antibodies, which do not share a common technical feature which is based on a common property or special technical feature not found in the prior art. These agonists, antagonists, nucleic acids, polypeptides, and antibodies, are independent and distinct chemical compounds lacking either a common structural property which distinguishes them as group from structurally related

compounds of the prior art or which provides them with a common utility which is lacking from those prior art agonists, antagonists.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and XIV are independent and distinct, each from the other, because they are products which possess characteristic differences in structure and function and each has an independent utility, that is distinct for each invention which cannot be exchanged. The protein of invention I can be used as a probe, or used therapeutically or diagnostically, e.g. in screening. The antibody of invention XIII can be used to obtain the nucleic acid encoding the protein of Group I, and can also be used in diagnostics, e.g. as a probe in immunoassays.

Inventions II-XIII are independent and distinct, each from the other, because the methods are practiced with materially different products which are structurally and chemically different, the novelty of the inventions lying in the products being administered and not the processes. The only feature in common in the instant inventions is "a method of treating an immune or proliferative disorder", which does not constitute the special technical feature lacking from the prior art because this method can be used with a composition other than the instant products such as corticosteroids. Distinctness is further shown because each of these products in each method can be made and used without any one or more of the other products. The products in the different Groups are physically, chemically and biologically distinct from each other, and if patentable would support separate patents. Furthermore, separate search terms would be required for searching the literature, eg. a search of the literature for an association of the nucleic acid of SEQ ID NO:5 with the claimed method would not necessarily reveal art for an association of the protein of SEQ ID NO:6 with the claimed method.

Inventions I and II-XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Inventions XIV and II-XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Having shown that these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their recognized divergent subject matter as defined by MPEP § 808.02, the Examiner has *prima facie* shown a serious burden of search (see MPEP § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (571) 272-0876. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (571) 271-0871.

Official papers filed by fax should be directed to (703) 872-9306. Faxed draft or informal communications with the examiner should be directed to (571) 273-0876.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Prema Mertz

Prema Mertz Ph.D.
Primary Examiner
Art Unit 1646
February 12, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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10/032,106	12/21/2001	Zaoyuan Peng	433112000700	5878

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EXAMINER	
MERTZ, PREMA MARIA	

ART UNIT	PAPER NUMBER
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DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.